

REMARKS

1. Introduction

Applicants note with appreciation the allowance of claims 11-14. However, Applicants desire to proceed with the remaining claims.

2. Rejection of Claims 1 and 15

In the Office Action claims 1 and 15 were rejected as allegedly being obvious over Cheston et al. in view of United States Patent Application Publication 2002/0083367 to McBride et al. In the Final Office Action it was alleged that the arguments set forth therein were unpersuasive alleging that the contention of inoperability of modifying McBride et al. should the same be combined with Cheston, because the same are directed to the same problem. It is Applicants' position that the reasoning set forth in the Office Action is incongruent with established case law. First, inoperability is line of reasoning by which to preclude any suggestion to modify teachings reference, independent of the problem being solved. See *In re Gordon*, 211 USPQ 1125, 1127 (Fed. Cir. 1985). Specifically, there is no suggestion to modify teachings to render the intended function of the teachings inoperable, regardless of the problem to which the teachings are directed. See *id.* The analysis concerning modifications of teachings based upon the problem-solution analysis is a different line of reasoning. See *In re Nomiya et al.*, 184 USPQ 609, 613 (CCPA 1975)(finding that where the prior art fails to identify the problem solved by a claimed invention obviousness may not be present) and *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969)(finding that obvious may not lie where a prior art invention fails to recognize a problem solved by the claimed invention even though "the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use . . .").

To make salient the deficiencies in the rejections Applicants point out that it is admitted in the Office Action that admitted was Cheston et al.'s failure to teach accessing boot up data in O/S accessible storage that has been copied from O/S inaccessible storage. Both claims 1 and 15 include the features of copying boot data from O/S inaccessible storage to O/S accessible storage and booting the system from the O/S accessible storage. These features are wholly absent from McBride et al. McBride et al. teach having a dual-boot system. See ¶ [0033]. McBride et al. advocate booting the computer system employing either the main logical drive or from the recovery logical drive. See ¶ [0032]. As a result, the

recovery logical drive is not described as being inaccessible by the operating system, i.e. both drives are accessible to the computer system. This is opposite to Applicants' claimed invention. Moreover, there is no suggestion to modify McBride et al. to include Applicants' claimed features, because doing so would render a desired function of McBride et al. invention inoperable for its intended purpose. McBride et al. makes clear that the invention disclosed is directed to a method and apparatus for restoring a computer system to a default factory image. See ¶ [0012]. It is respectfully contended, therefore, that there is no suggestion to combine the teachings of McBride et al. with Cheston et al., because doing so would prevent McBride et al. from achieving the desired goal of making the recovery logical drive (back up data) always accessible to the operating system. Based upon the foregoing, Applicants respectfully contend that a *prima facie* case of obviousness is not present with respect to claims 1 and 15.

3. Claims 1 and 16

In addition to the arguments set forth above, claim 1 and amended claim 16 recite additional features that define methods suitable for patent protection: copying boot up data from an O/S inaccessible container to an O/S accessible container, if boot up using the boot up data from O/S/ accessible container fails, and booting the computer system using the boot up data copied into the O/S accessible container from the O/S inaccessible container.

Applicants advocate this method in order to prevent contamination of backup boot data stored on a computer system. See, page 4, lines 1-3; page 9, lines 1-3. As a result, Applicants desire to have back up boot data available to the computer system that has a low risk of becoming infected with one or more viruses. See page 9, lines 3-6. To that end, the data is stored in a memory space that is not accessed by a computer's operating system (O/S).

In the Office Action reliance was placed upon the teachings of a link to the internet that is recited in column 5, lines 65-67 of Cheston et al. (See Final Office Action, page 7). Applicants have retrieved a printout of the text at this link and note that the date recited thereon is October 31, 2006. As a result, Applicants cannot honestly admit that the same qualifies as prior art. Moreover, MPEP section 2128 makes clear that absent a publication date of retrieval, Internet or on-line information cannot be relied upon as prior art pursuant to 35 USC sections 102(a) or 102(b). Therefore, Applicants respectfully submit that this ground for rejection has been traversed.

Moreover, the prior neither alone nor in combination teach or suggest copying boot up data from an O/S inaccessible container to an O/S accessible container, if boot up using the

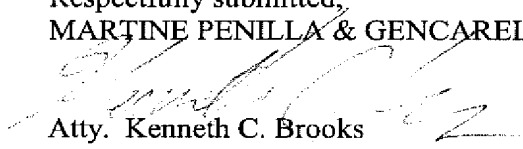
boot up data from O/S/ accessible container fails, and booting the computer system using the boot up data copied into the O/S accessible container from the O/S inaccessible container. As stated above, Cheston et al. teach copying boot up data from an O/S inaccessible storage to O/S accessible storage. McBride et al., on the other hand, do not teach O/S inaccessible storage. As mentioned above, McBride et al. make clear that the invention disclosed is directed to a method and apparatus for restoring a computer system to a default factory image. See ¶ [0012]. To that end, McBride et al. teach having a dual-boot system and advocate booting the computer system employing either the main logical drive or from the recovery logical drive. See ¶¶ [0032] and [0033]. As a result, the recovery logical drive is not described as being inaccessible by the operating system, which is opposite to the teachings of Applicants. It is respectfully contended, therefore, that a *prima facie* case of obvious is not present with respect to claim 1 and amended claim 16.

4. Remaining Dependent Claims

Considering that the remaining dependent claims include all of the features of the independent claims from which they depend, the dependent claims are patentable to the extent that the independent claims are patentable. As a result, Applicant respectfully contends that a *prima facie* case of obviousness is not present with respect to the dependent claims for the reasons set forth above with respect to the independent claims from which they depend.

Therefore, Applicant respectfully request further examination in view of the amendments and remarks set forth above. A Notice of Allowance is earnestly solicited. If the Examiner has any questions concerning the present response, the Examiner is kindly requested to contact the undersigned at (408) 774-6910. If any fees are due in connection with filing this response, the Commissioner is authorized to charge Deposit Account No. 50-0805 (Order No ADAPP230).

Respectfully submitted,
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